REMARKS

In the Office Action the Examiner noted that claims 1-13 were pending in the application and the Examiner rejected all claims. By this Amendment, claims 1 and 10 have been amended. Claims 1-13 remain pending in the application. The Examiner's rejections are traversed below.

Rejection of Claims 10-13

In item 2 on page 2 of the Office Action, the Examiner rejected claims 10-13 under 35 U.S.C. §102(b) as unpatentable over U.S. Patent 5,805,412 to Yanagisawa et al.

Claim 10 has been amended so that it now depends from claim 1. Therefore, it is submitted that claim 10 patentably distinguishes over the prior art for the same reasons as claim 1. These reasons are explained in detail below.

Referring to claim 11, the Examiner takes the position that Yanagisawa et al. discloses two connection parts (221, 321) in Figures 6 and 9. In the recitation of claim 11, two connection parts (i.e., the second connection part and the third connection part) are connectable to the electronic hardware.

Specifically claim 11 recites:

a second connectable to the electronic hardware;

a third connection part connectable to the electronic hardware, said third connection part being used to connect at least one of said plurality of units to the electronic hardware, and said second connection part being used to connect the rest of said plurality of units to the electronic hardware.

Therefore, in order to anticipate claim 11, Yanagisawa et al. must disclose two connection parts for connecting to the electronic hardware 100. However, Yanagisawa et al. has <u>only a single connection part for connecting to the electronic hardware 100.</u> In contrast, claim 11 recites two separate connectors connected to the electronic hardware.

The function expanding device of claim 11 provides significant advantages because the

third connection part may connect a conventionally connectable unit to the electronic hardware, while the second connection part may connect to the electronic hardware newly introduced units designed to be connected to it. Further, when the unit group is divided into second and third connection parts, the number of units for each connection part is reduced (see page 7, line 23 to page 8, line 7 of the subject application). Therefore, it is submitted that claim 11 patentably distinguishes over the prior art.

Claims 12 and 13 depend from claim 11 and include all of the features of that claim plus additional features which are not taught or suggested by the prior art. Therefore, it is submitted that claims 12 and 13 patentably distinguish over the prior art.

Rejection of Claims 1-6 and 8

In item 3 on pages 2-3 of the Office Action, the Examiner rejected claims 1-6 and 8 under 35 U.S.C. §102(e) as anticipated by U.S. patent application publication U.S. 2002/0008497 to Tanaka et al.

With respect to claim 1, in the response to the prior Office Action the applicants urged that the Tanaka reference does not teach or suggest an operation part that enables a user to drive the unit independent of driving the unit by the electronic hardware. At the bottom of page 4 of the Office Action the Examiner takes the position that "the operation part of Tanaka et al. is inherent to any music CD drive, a CD ROM drive, a DVD ROM drive and a LS-120 drive." Claim 1 has been amended to clarify the features of the present invention. In particular, claim 1, as amended, recites a function expanding device which comprises:

"an operation part that enables a user to drive the unit independent of driving the unit by the electronic hardware when the electronic hardware is not running a software application for the unit."

It is submitted that Tanaka et al. does not teach or suggest the above-identified feature.

In the Office Action the Examiner takes the position that Tanaka et al. teaches "an operation part that enables the user to drive the unit (110, 130, 140, 150, 160, 170, 180) independent of driving the unit (110, 130, 140, 150, 160, 170, 180) by the electronic hardware (40)." See pages 2 and 3 of the Office Action. As indicated above, the Examiner takes the position that "the operation part of Tanaka et al. is inherent to any music CD drive, a CD ROM drive, a DVD ROM drive and a LS-120 drive." (Page 4 of the Office Action.) However, it is

submitted that any "inherent" operation part which might be in Tanaka et al. would suffer from the same deficiencies as any other prior art apparatus:

"Control by the CPU in the PC body over the CD-ROM drive (or CD drive) etc. needs arduously run application software installed in the PC body even in an attempt to listen to a music CD." (See page 3, lines 11-13 of the subject application.)

It is submitted that claim 1 as amended more clearly distinguishes over such a prior art situation as described in the subject application and as disclosed in Tanaka et al. Therefore, it is submitted that claim 1 patentably distinguishes over the prior art.

Claims 2-6, and 10 depend, directly or indirectly from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the prior art. Therefore, it is submitted that claims 2-6, 8 and 10 patentably distinguish over the prior art.

Rejection of Claims 7 and 9

In item 5 on page 4 of the Office Action, the Examiner rejected dependent claims 7 and 9 as unpatentable over Tanaka et al. in view of U.S. Patent 6,073,187 to Jacobs et al. The Jacobs et al. reference generally describes controls and indicators, including master volume control buttons, a status indicator and a control switch for a secondary operational mode of a computer system, such as a mode for playing audio CDs in a CD ROM drive independent of an operating system. The Examiner takes the position that Jacobs et al. teaches a display part, which displays the status of the unit and a connector part having an IDE interface and a music interface. However, the Jacobs reference does not overcome the above-described deficiencies of Tanaka et al. Therefore, it is submitted that claims 7 and 9 patentably distinguish over the prior art.

Entry of Amendment

It is submitted that this Amendment amends claim 1 to clarify the features which have previously been argued in this case and which should not require any further consideration or search by the Examiner. In addition, claim 10 has been made a dependent claim, thereby simplifying consideration of this claim. Accordingly, it is submitted that this Amendment should be considered and entered by the Examiner.

Serial No. 09/477,405

Summary

It is submitted that none of the references, either taken alone or in combination, teach the present claimed invention. Thus, claims 1-13 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early notice of allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 1-22-04

Зу: 📈

John C. Garvey

Registration No. 28,607

1201 New York Ave, N.W., Suite 700

Washington, D.C. 20005 Telephone: (202) 434-1500

Facsimile: (202) 434-1500